

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

Dushyant Sharma

Art Unit: 3691

Application No.: 09/751,265

Examiner: Olabode Akintola

Filed: December 29, 2000

For: Integrated Systems for Electronic
Bill Presentment and Payment

APPELLANT'S REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In support of an appeal from the rejection dated December 27, 2006, the Notice of Appeal filed on April 26, 2007, the Notice under 37 CFR 41.37, and the Examiner's Answer, Appellant now submits this Reply Brief and requests that this appeal be maintained.

<i>CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8</i>			
I hereby certify that this Appellant's Appeal Brief and all accompanying documents are, on the date indicated below, <input checked="" type="checkbox"/> being transmitted to the United States Patent and Trademark Office via the Electronic Filing System.			
<i>Name (Print/Type)</i>	Patricia L. Volkert		
<i>Signature</i>	Patricia L. Volkert	<i>Date</i>	December 4, 2007

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Status of Claims

Claims 1-20 were rejected in the Office Action mailed on December 27, 2006.

Claims 1-20 are being appealed.

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Grounds of Rejection to be Reviewed on Appeal

The grounds of rejection to be reviewed on appeal are whether there is error in the rejection of Claims 1-16 and 18-20 under 35 U.S.C. § 102(e) as being anticipated by Haseltine, U.S. Patent 6,578,015 (Haseltine) and whether there is error in the rejection of claim 17 as being unpatentable over the Haseltine patent in view of Kamen et al., U.S. Patent 6,421,067 (Kamen).

Argument

Appellant appeals the rejection of Claims 1-16, 18-20 under section 102(e) as being anticipated by Haseltine, and the rejection of claim 17 under section 103(a) as being obvious.

The Examiner's reliance on "capable of" language is not proper in maintaining rejection of independent claims 1 and 8.

A claim is anticipated only if each and every limitation of the claim is found either expressly or inherently in a single prior art reference. Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc., 246 F.3d 1368, 1374 (Fed. Cir. 2001) (affirming invalidity of claims because of anticipation). The Examiner relies on the claim language "capable of" in the Examiner's Answer. The system of Claims 1 and 8 recite specific limitations, each with several qualifications and modifications. Haseltine does not disclose at least "each visual interface being supported by a web portal or bill presentment and payment website different from other of the visual interfaces, each of the visual interfaces allowing a consumer to review and pay the consumer's bills and thereby change information in the database only if the consumer has been authorized access to the database by a credit verifier bill data processor coupled to the data base." This claim language provides positive limitations of the claims. The rejection cites Haseltine, col. 9, lines 52-60, col. 10 lines 44-65 and col. 11 lines 31-47 for the visual interfaces limitations of Claims 1 and 8.

Col. 9, lines 52-60 of Haseltine teach that a customer may log onto a website of a biller through the Internet via, for example, an HTML Secure Sockets Layer (HTML

SSL) to view and pay bills, in which case the biller can maintain a database shown in FIG. 4 on an appropriate server. Col. 10, lines 44-65 of Haseltine teach a different embodiment where a thin-consolidator maintains a database similar to the database shown in FIG. 4 of Haseltine and customers use the Internet to log onto the website maintained by the thin-consolidator through, for example an HTML SSL to view and pay bills. Col. 11 lines 31-47 of Haseltine teach that a translator is used to transform biller data into a format appropriate for storage in the database shown in FIG. 4 of Haseltine and that a customer uses the Internet to log onto a website via, for example, an HTML SSL to view and pay bills. These columns do not discuss, and thus do not disclose, any mention of a plurality of visual interfaces each associated with a different web portal or bill presentment and payment website different from other visual interfaces that allow a consumer to review and pay bills, thereby changing information in the database.

Clearly, Haseltine does not disclose at least a plurality of visual interfaces as claimed. Since Haseltine does not disclose these limitations, Haseltine does not disclose each visual interface being supported by a web portal or bill presentment and payment website different from other of the visual interfaces, each of the visual interfaces allowing a consumer to review and pay the consumer's bills and thereby change information in the database only if the consumer has been authorized access to the database by a credit verifier bill data processor coupled to the data base.. *See In re Oelrich*, 666 F.2d 578 (C.C.P.A. 1981) (reversing rejections for anticipation). Because the reference does not disclose at least these limitations of Claims 1 and 8, there is no anticipation of Claims 1 and 8, which is therefore allowable. Accordingly, the rejection of Claims 1 and 8 is error.

Examiner's reliance on "adapted to" language to reject claims 4-6, 8, 10-20 is not proper in maintaining rejection of claims.

Each of claims 4-6, 8, and 10-20 of this application includes a positive limitation that uses the phrase "adapted to" in the claim. For example, claim 4 has "adapted to utilize"; claims 5-6 have "adapted to employ"; claim 8 has "adapted to prompt"; and claims 10-20 have "adapted to allow" as a positive claim limitation. Applicants have gone on record through prior arguments during prosecution that the limitations that use the "adapted to" phrase is required. In response to the Applicants prior arguments that Haseltine is completely the void of any such requirement, the Examiner in the Examiner's Answer now states that the limitation "adapted to " does not constitute a positive limitation in any patentable sense. However, as specifically set forth in MPEP § 2111.04 the phrase "adapted to" is described as raising a question as to the limiting affect of that language. In the Examiner's Answer, the Examiner is now ignoring these limitations and the distinction that they provide over the prior art based on an assertion that such phrase "does not constitute a positive limitation." The USPTO does not endorse such a position and has, quite to the contrary, discussed the acceptability of such language as a limitation in a patentable sense in the MPEP. The acceptance of such language is confirmed by the Board of Patent Appeals and Interferences, which has overturned rejections from examiners who ignore such limitations. Indeed, the Court of Appeals for the Federal Circuit has set precedent that must be followed and that recognizes such limitations as being capable of patentably distinguishing a claim over the prior art. As such, the Applicants respectfully submit that it is a legal error to ignore such limitations.

The CCPA decided in 1976 that limitations such as "members adapted to be positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976). It is this principle and case that are adopted by the USPTO and cited in MPEP § 2173.05(g).

Also, Congress passed the Federal Courts Improvement Act (“FCIA”) in 1982. Among other important changes to the federal court system, the FCIA created a new court: the United States Court of Appeals for the Federal Circuit.¹ As described by the Honorable Howard T. Markey, former Chief Judge of the CAFC, the court “rose from the ashes of two former courts”--“the 127 year old United States Court of Claims and the 73 year old United States Court of Customs and Patent Appeals [CCPA].”² Unlike the prior CCPA whose jurisdiction was limited concerning pending applications, Congress granted the newly created CAFC exclusive appellate jurisdiction over patent cases that were previously heard by the regional circuit courts of appeals. By creating the CAFC, Congress achieved its central purpose “to reduce the widespread lack of uniformity and uncertainty of legal doctrine that exist in the administration of patent law.”³ As such, legal precedent from the CAFC on patent cases is controlling on all US District Courts and Federal Agencies, including the United States Patent and Trademark Office. It cannot be ignored during the examination of a pending application.

When the decisions of the CAFC are examined, it is clear that the new position stated by the Examiner that limitations beginning with the phrase "adapted to" do not constitute a positive limitation " is not in conformance with Federal law. When the MPEP is examined, it is also clear that such a position is not in conformance with the examination procedures of the USPTO recognizing such CAFC precedent.

Quite to the contrary, the Court of Appeals for the Federal Circuit ruled in 2005 that whether such a phrase forms a limitation in a claim depends upon the specific facts of the case. See *In Hoffer v. Microsoft Corporation*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005) and see *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 USPQ2d 1871, 1876 (Fed Cir. 1990). These recent CAFC holdings are also adopted and reflected in the examination procedures set forth in the Manual of Patent Examination Procedures. Specifically, MPEP § 2111.04 states that usage of the phrase “adapted to” in

¹ Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, 96 Stat. 25 (1982).

² United States Judicial Conference Committee on the Bicentennial of the Constitution of the United States, *United States Court of Appeals for the Federal Circuit: A History 1982-1990*, at 1 (1991) [hereinafter “*History of the CAFC*”].

³ H.R. Rep. No. 97-312, at 21-22 (1981) [hereinafter “House Report”].

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a claim raises a question as to the limiting effect of that language, and MPEP § 2173.05(g) states that limitations such as "members adapted to be positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly citing *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976).

In other words, both the Court of Appeals for the Federal Circuit and the United States Patent and Trademark Office recognize that the phrase "adapted to" may state a condition that is material to patentability and that such language cannot be ignored in order to change the substance of the invention. Such is the case with the claims of the present application. In addition, the Applicants have specifically gone on the record to indicate that these phrases provide a limitation on the claim and have argued how such limitations clearly differentiate the claimed invention from that taught by Haseltine and Kamen. Therefore, such limitations cannot be ignored by the Examiner. To do so is a legal error. Accordingly, there is error in the rejection of claims 4-6, 8, 10-20.

Appellant has shown that the rejection of Claims 1-20 under 35 U.S.C. §§ 102(e) and §§ 103(a) is error. Appellants and the attorney below earnestly request that the Board reverse the rejections of Claim 1-20 and allow the claims of the application.

Respectfully submitted,

/Kevin L. Wingate/
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Date: December 4, 2007